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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,813	09/22/2003	Petra Jakobstroer	DT-6630	1974
30377	7590	09/26/2006		
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621				
EXAMINER COONEY, JOHN M				
ART UNIT			PAPER NUMBER	
1711				

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,813

Applicant(s)

JAKOBSTROER ET AL.

Examiner

John m. Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54,55,57-61 and 63-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54,55,57-61 and 63-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1105.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-22-05 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54, 55, 57-61, and 63-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horn et al.(5,512,602) in view of Bleys(5,521,226).

Horn et al. disclose preparations of two-component polyurethane foam forming systems comprising a polyol component containing polyol, water, additional blowing gases, polymer dispersions mixed with said water and polyol, stabilizers reading on those and in amounts as claimed, activators, assistants, fire retardants, fillers, and additives and an isocyanate component containing polyisocyanates, wherein the

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materials are combined at NCO Indexes meeting those as claimed (see the abstract, column 2 line 28 – column 3 line 53, column 5 lines 40-56, column 8 line 63 et seq., columns 9, 10, and 11, and the examples, as well as, the entire document).

Horn et al. differs from applicants' claims in that water in the elevated amounts recited by applicants' claims is not particularly required. However, Bleys demonstrates employment of water as a blowing additive in polyurethane synthesis operations in amounts meeting those claimed for the purpose of imparted foaming effect (see column 3 lines 13-18). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed water within the teaching of Horn et al. in amounts disclosed by Bleys for the purpose of increasing the water foaming effect in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Additionally, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. (see also MPEP 2144.05 I) Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54, 55, 57-61, and 63-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asako et al.(5,668,187) in view of Horn et al.(5,512,602).

Asako et al. disclose preparations of two-component polyurethane foam forming systems comprising a polyol component containing polyol, water, additional blowing gases, polymer dispersions mixed with said water, stabilizers, activators, assistants, fire retardants, fillers, and additives and an isocyanate component containing polyisocyanates, wherein the materials are combined at NCO indexes meeting those as claimed (see the entire document).

Asako et al. differs from applicants' claims in that water in the elevated amounts recited by applicants' claims is not particularly required. However, Asako et al. demonstrates employment of the water emulsions in varied amounts up to the values of applicants' claims for the purpose of controlling its imparted foaming and polymer emulsion incorporating effect (column 3 lines 11-19). It has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the

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optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. (see also MPEP 2144.05 I) Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed water within the teaching of Asako et al. in elevated amounts for the purpose of increasing its foaming effect in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Asako et al. differs from applicants' claims in that stabilizers as claimed are not particularly required. However, Horn et al. discloses employment of stabilizers as claimed in amounts as claimed to be well known in polyurethane synthesis operations for the purpose of imparted their stabilizing effects(see column 10 lines 32-44). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the stabilizers of Horn et al. in the preparations of Asako et al. for the purpose of imparting their stabilizing effects in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Additionally, it is held again here that it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ

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233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. (see also MPEP 2144.05 I) Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Applicants' arguments have been considered in light of the above new rejections. However, rejections are held to be properly set forth and maintained.

When considering showings of results, the following must be considered:

Claims Must be Commensurate With Showings:

Evidence of superiority must pertain to the full extent of the subject matter being claimed. *In re Ackerman*, 170 USPQ 340; *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *Ex Parte A*, 17 USPQ 2d 1719; accordingly, it has been held that to overcome a reasonable case of prima facie obviousness a given claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. Further, a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. See also *In re Kulling*, 14 USPQ 2d 1056.

Results Must be Unexpected:

Unexpected properties must be more significant than expected properties to rebut a prima facie case of obviousness. *In re Nolan* 193 USPQ 641 CCPA 1977.

Obviousness does not require absolute predictability. *In re Miegel* 159 USPQ 716.

Since unexpected results are by definition unpredictable, evidence presented in comparative showings must be clear and convincing. *In re Lohr* 137 USPQ 548.

In determining patentability, the weight of the actual evidence of unobviousness presented must be balanced against the weight of obviousness of record. *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *In re Beattie*, 24 USPQ 2d 1040.

Result Must Compare to Closest Prior Art:

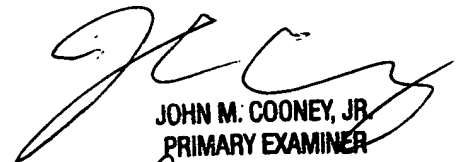
Where a definite comparative standard may be used, the comparison must relate to the prior art embodiment relied upon and not other prior art – *Blanchard v. Ooms*, 68 USPQ 314 – and must be with a disclosure identical (not similar) with that of said embodiment: *In re Tatincloux*, 108 USPQ 125.

Applicants' have not persuasively demonstrated unexpected results for the combinations of their claims. Applicants' showings are not commensurate in scope with the broadly encompassed claims. Applicants need to demonstrate their results to be clearly and convincingly unexpected and more than mere optimizations of the knowledge in the art or more significant than being secondary in nature, and comparisons need to be made with prior art embodiments relied upon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700